

REMARKS

Claims 1-13 are pending. Claims 6-13 have been withdrawn. Claims 14-18 have been added. Accordingly, claims 1-5 and 14-18 are at issue.

Claim 1 has been amended to overcome the rejection of claims 1-5 under §112. Specifically, claim 1 has been amended to delete the recitation of an antirotation tube in the body of the claim. This clarifies that it is a cylindrical tube that is being referred to in the body of the claim by the statement "said tube".

The rejection of claims 1-3 as unpatentable over Wallace 3,098,542 in view of Krenning 2,935,049 is respectfully traversed. The rejection is based upon an improper modification of Wallace by Krenning and fails to establish a *prima facie* case of obviousness as required under MPEP §§2142, 2143 *et. seq.*

More specifically, the Office Action correctly acknowledges that the primary reference, Wallace, fails to disclose a manual actuator and a linkage as recited in claims 1-3. To overcome the acknowledged shortcomings of Wallace, the Office Action attempts to modify the structure of Wallace with the manual actuator of Krenning using the stated rationale that the proposed modification "would provide the apparatus with a means of successfully lifting and raising the lift without the fear of the lift accidentally falling and risking injury to persons located below the lift." However, this rationale fails because the structure of Wallace, without any modification whatsoever, already provides "a means of successfully lifting and raising the lift without the fear of the lift accidentally falling and risking injury to persons below the lift." Indeed, that is the very purpose of the structure disclosed in Wallace. It cannot fairly be asserted that there is a motivation to modify

Wallace with Krenning to provide a benefit that already exists in the structure of Wallace. Accordingly, the rationale stated in making the rejection fails to establish a *prima facie* case as required in MPEP §2142, 2143 *et. seq.*

Indeed, given the additional cost and complication that the proposed modification would add to the structure disclosed in Wallace, one skilled in the art would avoid the proposed modification because it is contrary to the expressly stated objects of Wallace to provide a lift which “simple”, “durable”, “economical in construction”, and “dependable in operation”. Specifically, the addition of all of the components required to incorporate the manual actuator of Krenning into the structure of Wallace would unarguably complicate the structure of Wallace, which is completely contrary to Wallace’s express object of being “simple”. Furthermore, it is axiomatic that whenever additional components are added to a mechanism, durability and dependability tend to suffer due to the additional number of potential points of failure. In this case, the additional components required to add the manual actuator of Krenning to Wallace would have a negative effect on durability and dependability because the increased number of moving components, all of which can be negatively affected by dirt and/or corrosion, and all of which introduce the possibility of jamming due to such dirt and/or corrosion, and/or misalignment. Accordingly, the proposed modification is contrary to Wallace’s express objects of “durable” and “dependable in operation”. Lastly, it also cannot fairly be argued that the addition of the manual actuator of Krenning to the structure of Wallace would do anything other than increase the costs of manufacture due to the increased number of components and the complexity that would be added to the structure of Wallace. Accordingly, the proposed modification is contrary

to yet another express object of the invention of Wallace, i.e., "economical to manufacture".

In view of each of the foregoing reasons, taken alone or together, the proposed modification of Wallace by Krenning is improper, as is the rejection under §103.

Applicants respectfully traverse the rejection of claims 4-5 as unpatentable over Wallace in view of Krenning as applied to claims 1-3, and in further view of Mortenson 4,078,676. As discussed above, the base modification of Wallace in view of Krenning is improper. For this reason alone, the rejection of claims 4-5 should be withdrawn.

Furthermore, the proposed further modification in view of Mortenson is improper because Mortenson is nonanalogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." MPEP §2141.01(a) quoting from *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." MPEP §2141.01(a) quoting from *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In this case, Mortenson is directed towards a self-storing lift gate assembly for trucks or the like and accordingly is not in the field of applicant's endeavor, which is automotive lift devices. Furthermore, Mortenson is not reasonably pertinent because there is nothing in Mortenson that would have logically commended itself to an inventor's

attention in considering his problem. In this case, even if the modification of Wallace in view of Krenning is accepted as proper, there is absolutely nothing in that proposed modification that would cause an inventor to look for a lost motion connection, let alone look for a lost motion connection such as disclosed in Mortenson. Indeed, there is nothing in the manual actuator disclosed in Krenning that indicates there is any need for a lost motion device. The disclosure of Wallace adds nothing in this regard. Furthermore, there is nothing in the rejection that indicates such a need, other than perhaps improper hindsight. In this regard, the rejection asserts that a lost motion connection is required "to accommodate moving the link assembly in the correct manner so that the dogs can be positioned to stop the lift assembly," but provides nothing to support this assertion. Specifically, absent from the rejection is any logic to support the statement that a lost motion device is required "to accommodate moving the link assembly in the correct manner". Indeed, there is nothing in the rejection to explain exactly what is meant by "the correct manner". There is certainly nothing in Krenning to indicate that lost motion is required to move its manual actuator in a "correct manner". Again, Wallace adds nothing in this regard. Absent some kind of supporting logic or rationale, the assertions in the rejection are completely insufficient to support using Mortenson as an analogous reference, and are further completely insufficient to establish any kind of a *prima facie* case of obviousness. In short, the rejection fails to point to anything in the structure of Wallace or Krenning that would indicate any need for a lost motion connection, let alone that the addition of a lost motion connection would be desirable as required to establish a *prima*

facie case of obviousness under §103. Accordingly, for each of the above reasons taken alone or together, the rejection of claims 4-5 is improper and should be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration of the rejections of claims 1-5 and consideration of new claims 14-18.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By 
Jeffery N. Fairchild
Reg. No. 37,825

October 20, 2006

500 West Madison Street
Suite 3800
Chicago, IL 60661
(312) 876-1800